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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHANMUGASUNDARAM RAVIKUMAR and
DANDAPANI SIVAKUMAR

Appeal 2008-1906
Application 10/035,999
Technology Center 2100

Decided: February 13, 2009

Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and
HOWARD B. BLANKENSHIP, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge.*

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-7, 9, and 14-17. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

The invention at issue on appeal enables a user to operate and customize a graphical user interface by specifying rank-order preferences. More specifically, the invention allows a user to rearrange, delete, or limit the number of items in a pull-down list so that the available items are positioned in accordance with his preferences. (Spec. 1.)

B. ILLUSTRATIVE CLAIM

The following claim further illustrates the invention.

1. A method for specifying user preferences, comprising:

generating a pull-down menu in a graphical user interface; and

enabling a user to move labeled items in said pull-down menu representing user choices describing variables in electronic commerce transactions such that relative positions of said items correspond to relative user preferences.

C. PRIOR ART

Kaplan	US 5,280,275	Jan. 18, 1994
Sasaki	US 6,122,005	Sep. 19, 2000
Mankoff	US 6,868,426 B1	Mar. 15, 2005 (filed Jul. 7, 2000)

Windows NT Screen Dumps ("WINNT")

D. REJECTIONS

Claims 1, 2, 6, 7, and 14-17 stand rejected under 35 U.S.C. § 103(a) as being anticipated by Sasaki, Kaplan, and Mankoff.

Claims 3-5 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sasaki, Kaplan, Mankoff, and WINNT.

II. CLAIM GROUPING

> When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.

37 C.F.R. § 41.37(c)(1)(vii) (2007).[1]

Here, the Appellants argue claims 1, 6, 7, and 14-17, which are subject to the same ground of rejection, as a group. (2d Supp. App. Br.[2] 5-7). Rather than arguing the rejection of claims 3-5 and 9 separately, they

[1] We cite to the version of the Code of Federal Regulations in effect at the time of the Appeal Brief. The current version includes the same rules.

[2] We rely on and refer to the second Supplemental Appeal Brief in lieu of the original Appeal Brief and the first Supplemental Appeal Brief, because the latter were defective. We have not considered the latter in deciding this appeal.

rely on their arguments for the group. (*Id.* 7-8.) We select claim 1 as the sole claim on which to decide the appeal of the group. "With this representation in mind, rather than reiterate the positions of the parties *in toto*, we focus on the issues therebetween." *Ex Parte Zettel*, No. 2007-1361, 2007 WL 3114962, at *2 (BPAI 2007).

III. ISSUE: MOVING MENU ITEMS

The Examiner concludes that "[w]hile the user [of Kaplan] may not physically move i.e. drag and drop the menu items into positions relative to user preferences, the claims do not convey this. The user is enabled to move the items by rating a particular menu item, and shifting the items according to respective ratings . . . ." (Ans. 9.) The Appellants argue "[t]hat . . . every one of the independent claims in the present invention is indeed directed to moving labeled items in a pull-down menu representing user choices." (Reply Br. 2.)

Therefore, the *issue* before us is whether the Appellants have shown error in the Examiner's finding that Kaplan enables a user to move items in a pull-down menu.

A. PRINCIPLES OF LAW

"[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d

1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

B. FINDINGS OF FACT ("FFS")

1. Claim 1 recites in pertinent part the following limitations: "generating a pull-down menu in a graphical user interface; and enabling a user to move labeled items in said pull-down menu . . . ."

2. Kaplan "allow[s] users of computers having a graphical user interface to efficiently convey scalar control information . . . ." (Abs., ll. 1-3.)

3. The reference "[c]apture[s] user's preferences for the layout and design of the interface itself." (Col. 5, ll. 17-18.)

4. "By clicking on a pull-down menu item, users could rate how often they need to use that menu choice. A high rating would cause the menu to rearrange itself so that it appears first on the pull-down menu. A lower rating would cause the item to appear later in the menu list. (See FIGS. 4, 44)." (*Id.* ll. 18-24.)

C. ANALYSIS

We agree with the Examiner that claim 1 does not require a user to physically or manually move, i.e. drag and drop, menu items into positions. Giving the representative claims the broadest, reasonable construction, the

limitations merely require enabling a user to move items in a pull-down menu.

In Kaplan, when a user rates how often he needs to use a choice in a pull-down menu, the menu rearranges the labeled choices therein to reflect the rating. (FF 4.) Such an operation enables the user to move labeled items in the pull-down menu.

D. CONCLUSION

Based on the aforementioned facts and analysis, we conclude that the Appellants have shown no error in the Examiner's finding that Kaplan enables a user to move items in a pull-down menu.

IV. ISSUE: INTENDED USE OR PURPOSE

The Examiner finds that "Kaplan teaches enabling a user to move labeled items in said pull-down menu (Column 5 lines 17-24) representing user choices such that relative positions of said items correspond to relative user preferences (Column 5 lines 17-24)." (Ans. 4.) The Appellants argue that "Kaplan goes to frequency, not to a specified preference . . . , i.e. Kaplan allows the layout and design of an interface to be modified so that frequently used menu choices appear higher in a menu list." (Reply Br. 2.)

Therefore, the *issue* before us is whether the Appellants have shown that the recitation of "relative positions of said items correspond to relative user preferences" is entitled to patentable weight.

A. PRINCIPLES OF LAW

"An intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates." *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003). Although "[s]uch statements often . . . appear in the claim's preamble," *In re Stencel*, 828 F.2d 751, 754 (Fed.Cir. 1987), a statement of intended use or purpose can appear elsewhere in a claim. *Id.*

B. FINDING OF FACT

5. Claim 1 recites in pertinent part the following limitations: "enabling a user to move labeled items in said pull-down menu representing user choices describing variables in electronic commerce transactions such that relative positions of said items correspond to relative user preferences."

C. ANALYSIS

The phrase "such that relative positions of said items correspond to relative user preferences" (FF 5) merely states an intended use or purpose for the claimed step of "enabling a user to move labeled items in a pull-down menu" (FF 1). It does no more than define a context in which the invention operates. The phrase is not entitled to patentable weight and, therefore, cannot distinguish over Kaplan.

D. CONCLUSION

Based on the aforementioned facts and analysis, we conclude that the Appellants have not shown that the recitation of "relative positions of said items correspond to relative user preferences" is entitled to patentable weight.

V. ISSUE: DELETING ITEMS

The Examiner finds that "[a]s agreed on by the Applicant a user is able to activate and deactivate particular cameras. Furthermore if a camera is deactivated or powered OFF the relevant camera is not displayed on the list even if it has a high frequency of use (Column 12 lines 36-48)." (Ans. 9.) The Appellants argue that "Sasaki fails to teach enabling a user to delete items representing unacceptable user choices . . . ." (2d Supp. App. Br. 7.)

Therefore, the *issue* before us is whether the Appellants have shown error in the Examiner's finding that Sasaki enables a user to delete items from a pull-down menu.

A. FINDINGS OF FACT

6. Claim 2 recites in pertinent part the following limitations: "a user deleting said items representing unacceptable user choices."

7. The Appellants admit that "Sasaki does allow a user to activate and deactivate particular cameras . . . ." (2d Supp. App. Appeal Br. 7.)

8. In Sasaki "when a camera name selected by default in FIG. 4 or a list of camera names displayed in the pull-down menu of FIG. 5 is displayed, it is determined at this time whether the communication terminal is one being supplied with power. If the communication terminal is one whose power supply is OFF, the relevant camera name is not displayed in the list . . . ." (Col. 12, ll. 36-42.)

B. ANALYSIS

The phrase "representing unacceptable user choices" (FF 6) merely states an intended use or purpose for the items that are deleted. It does no more than define a context in which the invention operates. The phrase is not entitled to patentable weight. Giving the representative claims the broadest, reasonable construction, therefore, the limitations merely require enabling a user to delete items from a pull-down menu.

Sasaki allows a user to deactivate particular cameras. (FF 7.) The reference's pull-down menu, which lists cameras, omits those that have been deactivated. (FF 8.) Therefore, Sasaki enables a user to delete a particular camera from the pull-down menu by turning-off the camera.

C. CONCLUSION

Based on the aforementioned facts and analysis, we conclude that the Appellants have shown no error in the Examiner's finding that Sasaki enables a user to delete items from a pull-down menu.

VI. ORDER

We affirm the rejections of claims 1-7, 9, and 14-17.

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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